# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**PATENT** 

Applicants:

Michael J. Berardi, et al.

Docket No.:

60655.1400

Serial No.:

10/810,473

Filing Date:

August 30, 2004

Group Art Unit:

3621

Confirmation

9805

TITLE:

SYSTEM AND METHOD FOR

No.:

Examiner:

Kamal, Shahid

ENCODING INFORMATION IN

MAGNETIC STRIPE FORMAT FOR USE IN RADIO FREQUENCY

IDENTIFICATION TRANSACTIONS

# REQUEST TO EXAMINER TO ACKNOWLEDGE PROPER PRIORITY

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

#### Dear Commissioner:

Henry C. Yuen, SPE (571-272-4856), instructed us to file another Request for Corrected Filing Receipt and Request to Examiner to Acknowledge Proper Priority.

Applicants respectfully request that the full priority be acknowledged and the United States Patent and Trademark Office's records to be updated accordingly.

On March 26, 2004 the application was filed with the following priority paragraph:

This invention is a continuation in part of, and claims priority to U.S. Patent Application No. 10/192,488, entitled "SYSTEM AND METHOD FOR PAYMENT USING RADIO FREQUENCY IDENTIFICATION IN CONTACT AND CONTACTLESS TRANSACTIONS," filed on July 9, 2002 (which itself claims priority to U.S. Provisional Patent Application No. 60/304,216, filed July 10, 2001), and to U.S. Patent Application No. 10/340,352, entitled "SYSTEM AND METHOD FOR INCENTING PAYMENT USING RADIO FREQUENCY IDENTIFICATION IN CONTACT AND CONTACTLESS TRANSACTIONS," filed January 10, 2003 (which itself claims priority to U.S. Provisional Patent

Serial No. 10/810,473 Docket No. 60655.1400

Application No. 60/396,577, filed July 16, 2002), all of which are incorporated herein by reference.

Per the "Response to Request for Corrected Filing Receipt" mailed August 31, 2004, Applicants filed a Preliminary Amendment on January 5, 2005. The Preliminary Amendment clarified the relationship between the current application and U.S. Serial Nos. 10/340,352 and 60/396,577, as set forth below:

This invention is a continuation-in-part of, and claims priority to U.S. Patent Application No. 10/192,488, entitled "SYSTEM AND METHOD FOR PAYMENT USING RADIO FREQUENCY IDENTIFICATION IN CONTACT AND CONTACTLESS TRANSACTIONS," filed on July 9, 2002 (which itself claims priority to U.S. Provisional Patent Application No. 60/304,216, filed July 10, 2001), and is also a continuation-in-part of and claims priority to U.S. Patent Application No. 10/340,352, entitled "SYSTEM AND METHOD FOR INCENTING PAYMENT USING RADIO FREQUENCY IDENTIFICATION IN CONTACT AND CONTACTLESS TRANSACTIONS," filed January 10, 2003 (which itself claims priority to U.S. Provisional Patent Application No. 60/396,577, filed July 16, 2002), all of which are incorporated herein by reference.

Attached is a copy of the Declaration as filed. The priority information provided in the application as filed and the preliminary amendment as filed agree with the Declaration as filed.

We look forward to receiving correspondence acknowledging the proper priority for this application. If you should have any questions, please do not hesitate to contact the undersigned at the telephone number listed below.

Dated: August 31, 2010

Howard I. Sobelman, Reg. No. 39,038

Respectfully submitted,

SNELL & WILMER L.L.P.

One Arizona Center, 400 E. Van Buren Phoenix, Arizona 85004-2202

Phone: (602) 382-6228 Fax: (602) 382-6070

Email: hsobelman@swlaw.com



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s): Michael J. Berardi, et al.

Attorney Docket No.: 60655.1400

Serial No.:

10/810,473; Confirmation No.: 9805

Examiner

TBA

Date Filed: March 26, 2004

**Group Art Unit:** 

2635

Title:

SYSTEM AND METHOD FOR ENCODING INFORMATION IN

MAGNETIC STRIPE FORMAT FOR USE IN RADIO FREQUENCY

IDENTIFICATION TRANSACTIONS

#### **DECLARATION FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and sole inventor (if only one name is listed below) or an original, first and joint (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

### SYSTEM AND METHOD FOR ENCODING INFORMATION IN MAGNETIC STRIPE FORMAT FOR USE IN RADIO FREQUENCY IDENTIFICATION TRANSACTIONS

| the specification of which is attached hereto or was fil<br>Application Serial No. 10/810,473, and was amended on   |   |
|---|---|
| hereby state that I have reviewed and understand the conspecification, including the claims, as amended by any ame  |   |
| acknowledge the duty to disclose to the United States Patinformation known to me to be material to patentability as Federal Regulations, Section 1.56.  |   |
| I hereby claim foreign priority benefits under Title 35, U<br>119(a)-(d) or Section 365(b) of any foreign application<br>certificate, or Section 365(a) of any PCT International applicast one country other than the United States, listed believely, by checking the box, any foreign application for pate<br>PCT International application having a filing date before the<br>priority is claimed. | n(s) for patent or inventor's<br>plication which designated at<br>low, and have also identified<br>ent or inventor's certificate or |
| Prior Foreign Application(s)  | Priority Not Claimed  |
| , ipplication(c)  | Г 1   |

Number

Country

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below:

| 60/304,216         | July 10, 2001 |
|--------------------|---------------|
| Application Number | Filing Date   |
| 60/396,577         | July 16, 2002 |
| Application Number | Filing Date   |

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s), or §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

| 10/192,488         | July 9, 2002     |                                     |
|--------------------|------------------|-------------------------------------|
| Application Number | Filing Date      | Status (Patent, Pending, Abandoned) |
| 10/340,352         | January 10, 2003 | -                                   |
| Application Number | Filing Date      | Status (Patent, Pending, Abandoned) |

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

In the event that the Application Number and/or filing date is not available when this Declaration is executed, I hereby authorize and request any attorney associated with the Snell & Wilmer, L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

| Full name of first of |                           | I. Berardi                        |
|-----------------------|---------------------------|-----------------------------------|
| Inventor's signature  | : Michael J. Surand       | <u>Q'</u> Date: <u>08/10/0</u> (/ |
|                       | s: 7770 NW 50th St., #306 | 344                               |
| City/State:           | Lauderhill, Florida       | Zip Code: 33351                   |
| Citizenship:          | United States of America  |                                   |

| Full name of second     | joint inventor: <u>Michal Bliman</u> |                        |
|-------------------------|--------------------------------------|------------------------|
| Inventor's signature:   |                                      | Date:                  |
| Residence Address:      | 4 Dogwood Circle                     |                        |
| City/State:             | Matawan, New Jersey                  | Zip Code: <u>07747</u> |
| Citizenship:            | United States of America             |                        |
| Full name of third join | nt inventor: David S. Bonalle        |                        |
| Inventor's signature:   |                                      | Date:                  |
| Residence Address:      | 77 Rose Hill Avenue                  |                        |
| City/State:             | New Rochelle, New York               | Zip Code: <u>10804</u> |
| Citizenship:            | United States of America             |                        |
| Full name of fourth jo  | oint inventor: Peter D. Saunders     |                        |
| Inventor's signature:   |                                      | Date:                  |
| Residence Address:      | 3710 East Palisade Drive             |                        |
| City/State:             | Salt Lake City, Utah                 | Zip Code: <u>84109</u> |
| Citizenship:            | United States of America             |                        |



# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s): Michael J. Berardi, et al.

Attorney Docket No.: 60655.1400

Serial No.:

10/810,473; Confirmation No.: 9805

Examiner TBA

Date Filed:

March 26, 2004

**Group Art Unit:** 

2635

Title:

SYSTEM AND METHOD FOR ENCODING INFORMATION IN MAGNETIC STRIPE FORMAT FOR USE IN RADIO FREQUENCY

**IDENTIFICATION TRANSACTIONS** 

### **DECLARATION FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and sole inventor (if only one name is listed below) or an original, first and joint (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

# SYSTEM AND METHOD FOR ENCODING INFORMATION IN MAGNETIC STRIPE FORMAT FOR USE IN RADIO FREQUENCY IDENTIFICATION TRANSACTIONS

| the specification of which is attached he<br>Application Serial No. 10/810,473, and was   | ereto or was filed on March 26, 2004, as amended on (if applicable)  |
|---|--|
| I hereby state that I have reviewed and und specification, including the claims, as amen  | derstand the contents of the above-identified ded by any amendment referred to above.  |
|   | Inited States Patent and Trademark Office a patentability as defined in Title 37, Code of  |
| 119(a)-(d) or Section 365(b) of any fore certificate, or Section 365(a) of any PCT least one country other than the United Selow, by checking the box, any foreign ap | nder Title 35, United States Code, Section<br>eign application(s) for patent or inventor's<br>international application which designated a<br>states, listed below, and have also identified<br>oplication for patent or inventor's certificate of<br>g date before that of the application on which |
| Prior Foreign Application(s)  | Priority Not Claimed   |

Number

Country

| I hereby claim the benefit application(s) listed below:  | under 35 U.S.C. §119  | (e) of any United States provisional  |  |  |
|--|---|---|--|--|
| 60/304,216   | July 10, 2001   |   |  |  |
| Application Number   | Filing Date   |   |  |  |
| , ipplication, raining.  |   |   |  |  |
| 60/396,577   | July 16, 2002   |   |  |  |
| Application Number   | Filing Date   |   |  |  |
| §365(c) of any PCT Internat<br>and, insofar as the subject<br>disclosed in the prior Unite<br>paragraph of 35 U.S.C. §11<br>Patent and Trademark Office<br>as defined in 37 C.F.R. §1  | tional application design<br>at matter of each of<br>ed States application<br>12, I acknowledge the<br>se all information know<br>.56 which became av | of any United States application(s), or mating the United States, listed below the claims of this application is not in the manner provided by the first duty to disclose to the United States in to me to be material to patentability allable between the filing date of the nal filing date of this application: |  |  |
| 10/192,488   | July 9, 2002  |   |  |  |
| Application Number   | Filing Date   | Status (Patent, Pending, Abandoned)   |  |  |
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| Full name of first or joint inve   |   |   |  |  |
| Inventor's signature:  |   | Date:   |  |  |
| Residence Address: 7770 N  | NW 50th St., #306   |   |  |  |
| City/State: Laude  | rhill, Florida  | Zip Code: <u>33351</u>  |  |  |

Citizenship: United States of America

| Full name of second   | joint inventor: Michal Bliman           |                        |
|-----------------------|---|------------------------|
| Inventor's signature: | Midw Blimer                             | Date: <u>%/Iq/o</u>    |
| Residence Address:    | 4 Dogwood Circle                        |                        |
| City/State:           | Matawan, New Jersey                     | Zip Code: <u>07747</u> |
| Citizenship:          | United States of America                |                        |
|                       |   |                        |
| Full name of third jo | int inventor: David S. Bonalle          |                        |
| Inventor's signature: |   | Date:                  |
| Residence Address     | 77 Rose Hill Avenue                     |                        |
| City/State:           | New Rochelle, New York                  | Zip Code: <u>10804</u> |
| Citizenship:          | United States of America                |                        |
| Full name of fourth j | oint inventor: <u>Peter D. Saunders</u> |                        |
| Inventor's signature: |   | Date:                  |
| Residence Address     | 3710 East Palisade Drive                |                        |
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Applicant(s): Michael J. Berardi, et al.

Attorney Docket No.: 60655.1400

Serial No.: 10/810,473; Confirmation No.: 9805

Examiner

TBA

Date Filed: March 26, 2004

**Group Art Unit:** 

2635

Title:

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| the specification of which is attached hereto or was filed on March Application Serial No. 10/810,473, and was amended on   |   |
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| I hereby state that I have reviewed and understand the contents of the all specification, including the claims, as amended by any amendment referre   |   |
| I acknowledge the duty to disclose to the United States Patent and Trade information known to me to be material to patentability as defined in Titl Federal Regulations, Section 1.56.  |   |
| I hereby claim foreign priority benefits under Title 35, United States (119(a)-(d) or Section 365(b) of any foreign application(s) for patent certificate, or Section 365(a) of any PCT International application which least one country other than the United States, listed below, and have below, by checking the box, any foreign application for patent or inventor PCT International application having a filing date before that of the applic priority is claimed. | or inventor's designated at also identified 's certificate or |
| Prior Foreign Priority Application(s)   | Not Claimed   |
| - Aphicanolity  | []  |

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| I hereby claim the benefit application(s) listed below:  | under 35 U.S.C. §11  | 9(e) of any United States provisional  |
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| 10/192,488 Application Number  | July 9, 2002 Filing Date   | Status (Patent, Pending, Abandoned)  |
|  |  | Clares (Calani, Calania, Calania)  |
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| all statements made on int<br>these statements were ma-<br>like so made are punishal<br>Title 18 of the United State<br>the validity of the application<br>In the event that the Appl<br>Declaration is executed, I  | formation and belief are ade with the knowledge ole by fine or imprison as Code and that such to or any patent issued ication Number and/or hereby authorize and Customer No. 20322.             | filing date is not available when this request any attorney associated with to insert above the filing date and/or   |
| Full name of first or joint in   | ventor: <u>Michael J</u>   | J. Berardi   |
| Inventor's signature:  |  | Date:  |
| Residence Address: 7770  |  |  |
| City/State: Laud   |  | Zip Code: <u>33351</u>   |
|  |  |  |
| •  |  |  |

| Full name of second     | joint inventor: <u>Michal Bliman</u> |                                       |
|-------------------------|--------------------------------------|---------------------------------------|
| Inventor's signature:   |                                      | Date:                                 |
| Residence Address:      | 4 Dogwood Circle                     | ·                                     |
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| Citizenship:            | United States of America             |                                       |
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| Inventor's signature:   | NISSU                                | Date:                                 |
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| Citizenship:            | United States of America             |                                       |
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Applicant(s): Michael J. Berardi, et al.

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Examiner

**TBA** 

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| Prior Foreign  | Priority Not Claimed   |

Number

Application(s)

Country

| I hereby claim the benefit und application(s) listed below:   | der 35 U.S.C. §119(   | e) of any United States provisional  |
|---|---|--|
| 60/304,216  | July 10, 2001   |  |
|   | Filing Date   | <del></del>  |
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|   | nuary 10, 2003<br>ing Date  | Status (Patent, Pending, Abandoned)  |
| all statements made on inform<br>these statements were made<br>like so made are punishable to   | nation and belief are with the knowledge by fine or imprisonmode and that such wi   | my own knowledge are true and that believed to be true; and further that that willful false statements and the ent, or both, under Section 1001 of liful false statements may jeopardize nereon.   |
| Declaration is executed, I her  | eby authorize and re<br>ustomer No. 20322, t  | iling date is not available when this equest any attorney associated with to insert above the filing date and/or own.  |
| Full name of first or joint invent  | tor: Michael J.   | Berardi  |
| Inventor's signature:   |   | Date:  |
| •   |   |  |
|   |   | Zip Code: <u>33351</u>   |
|   |   |  |

| Full name of second     | joint inventor: <u>Michal Bliman</u> |                         |
|-------------------------|--------------------------------------|-------------------------|
|                         |                                      | Date:                   |
|                         | 4 Dogwood Circle                     |                         |
|                         |                                      |                         |
| City/State:             | Matawan, New Jersey                  | zip Code <u>07747</u>   |
| Citizenship:            | United States of America             |                         |
| Full name of third joir | nt inventor: David S. Bonalle        |                         |
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| Full name of fourth jo  | pipt inventor: Peter D. Saunders     |                         |
| Inventor's signature:   | ( Hur Jey )                          | Date: <u>8/16/04</u>    |
|                         | 3710 East Palisade Drive             | · •                     |
| City/State:             | Salt Lake City, Utah                 | Zip Code: <u>84109</u>  |
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